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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/775,591	02/05/2001	Kazunori Ukigawa	Q62966	9264

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EXAMINER

BORLINGHAUS, JASON M

ART UNIT PAPER NUMBER

3628

DATE MAILED: 11/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/775,591

Applicant(s)

UKIGAWA ET AL.

Examiner

Jason M. Borlinghaus

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 3,4,14,15,17,21 and 24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-13,16,18-20,22 and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 February 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/775,591.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/9/02 & 10/04/02</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of species one (Claims 1, 2, 5 – 13, 16, 18 – 20, 22 and 23) in the reply filed on 8/8/05 is acknowledged.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 6 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 6 is directed to neither a process nor a machine, but rather embraces and/or overlaps two different statutory classes of invention which 35 U.S.C. 101 is designed to prevent. *In Ex parte Lyell*, 17 USPQ2d 1548 (Bd. Pat. App. & Inter. 1990).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention. Claim 6 is directed to neither a process nor a machine, but rather embraces and/or overlaps two different

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statutory classes of invention which has deemed ambiguous under 35 U.S.C. 112. *In Ex parte Lyell*, 17 USPQ2d 1548 (Bd. Pat. App. & Inter. 1990).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 – 2, 5 – 6, 12 – 13, 16, 20 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koreeda (US Patent 5,890,137) in view of O'Leary (US Patent 6,609,113).

Regarding Claim 1, Koreeda discloses an online shopping system comprising:

- at least one user device (workstation) which is connected onto Internet (computer network) and for reading a merchant site (shopping mall) on the Internet (computer network). (see col. 5, line 33 – col. 6, line 2);
- an agent device (service center) which is connected to said at least one user device (workstation) and the merchant site (shopping mall), relays and sends a purchase instruction (product data) from said at least one user device (workstation) to the merchant site (shopping mall). (see col. 5, line 33 – col. 6, line 2);
- a settlement device (approval center) which is connected to the agent device (service center), and settles an account for a product purchased in

accordance with the purchase instruction (product data) sent from said at least one user device (workstation). (see col. 5, line 33 – col. 6, line 2);

- said at least one user device (workstation) including:
 - a purchase-instruction inputting means (product selection unit) for inputting an instruction for purchasing a product (selecting product) on sale in the merchant site (shopping mall). (see col. 2, lines 44 – 56);
 - a first purchase-instruction sending means for sending ID information of the user (personal data), as a first purchase instruction (first protocol), together with information regarding the product input (product data) by said instruction inputting means (product selection unit) to said agent device (service center). (see col. 2, lines 44 - 60);
 - said agent device (service center) including:
 - purchase-instruction receiving means for receiving the first purchase instruction sent (personal data, product data) from said first purchase instruction sending means. (see col. 2, lines 44 - 60);
 - second purchase-instruction sending means for sending (distribution unit), as a second purchase instruction, information regarding the product (product data) and being included in the first purchase-instruction received by said

instruction receiving means (supra), and information regarding the user (personal data) to the merchant site (shop systems). (see col. 6, line 53 – col. 7, line 2); and

- settlement requesting means for requesting said settlement device (approval center) for settling an account for the purchased product, based on the information regarding the product (product data) and being included in the instruction received by said purchase-instruction receiving means and the information regarding the settlement means (credit card data) of the user. (see col. 6, line 53 – col. 7, line 2).

Koreeda does not disclose an online system comprising:

- said agent device including:
 - user-information storage means for storing the ID information, user information regarding the user, and information regarding settlement means held by the user, in association with each other;
 - user information extraction means for searching said user-information storage means for user information based on the ID information of the user which is included in the first purchase-instruction, and extracting corresponding information regarding the user and corresponding information regarding the settlement

means, when said purchase-instruction receiving means receives the first purchase instruction;

- second purchase-instruction sending means for sending, as a second purchase instruction, information regarding the product and being included in the first purchase-instruction received by said instruction receiving means, and information regarding the user and being extracted by said user-information extraction means, to the merchant site; and
- settlement requesting means for requesting said settlement device for settling an account for the purchased product, based on the information regarding the product and being included in the instruction received by said purchase-instruction receiving means and the information regarding the settlement means of the user and being extracted by said user-information extraction means.

O'Leary discloses an online shopping system comprising:

- said agent device (wallet) including:
 - user-information storage (database) means for storing the ID information (user ID), user information regarding the user, and information regarding settlement means held by the user, in association with each other. (see supra, col. 9, line 62 – col. 10, line 13 – It is inherent that an information storage means exists

to allow the agent device (wallet) to store “form filling information” and “user’s ID”); and

- user information extraction means for searching said user-information storage means for user information based on the ID information of the user (user ID) which is included in the first instruction, and extracting corresponding information regarding the user (ie. shipping address, name) and corresponding information regarding the settlement means (ie. credit cards), when said instruction receiving means (Internet transmission) receives the instruction. (see col. 15, line 19 – col. 16, line 55 – It is inherent that the system extracts user information from the storage means based upon the input of the ID information of user (user ID)).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Koreeda by incorporating a storage means for storing user information and settlement means information, as disclosed by O’Leary, and then extracting that information for use, as disclosed by O’Leary, to provide allow for minimal repeated user entry of information and automatic completion of forms.

Regarding Claim 2, Koreeda discloses an online shopping system wherein:

- said agent device (service center) further includes inquiry means for inquiring whether the settlement means is valid (credit authorization

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check), based on the information regarding the settlement means of the user (payment settlement data). (see col. 6, line 53 – col. 7, line 2); and

- said second purchase-instruction sending means (distribution center) inserting information representing that inquiring is performed (data approved by approval center) by said inquiry means into the second purchase-instruction (payment authorization), and sending the second purchase instruction to the merchant site (shop systems). (see col. 6, line 53 – col. 7, line 2).

Koreeda does not teach an online shopping system wherein:

- said agent device further includes inquiry means for inquiring whether the settlement means is valid, based on the information regarding the settlement means of the user which is extracted by said user-information extraction means.

O'Leary discloses an online shopping system wherein:

- said agent device (wallet) further includes inquiry means for inquiring whether the settlement means is valid (sufficient balance), based on the information regarding the settlement means of the user (IPA account) which is extracted by said user-information extraction means (user information in database). (see col. 15, line 66 – col. 16, line 63).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Koreeda by incorporating a storage means for storing user information and settlement means information, as disclosed by O'Leary,

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and then extracting that information for use, as disclosed by O'Leary, to provide allow for minimal repeated user entry of information and automatic completion of forms.

Regarding Claim 5, neither Koreeda nor O'Leary teach an online shopping system wherein:

- said agent device and said settlement device are connected with each other through a private line.

Utilizing a private line or a private network for data transmission is old and well known in the art of computer system design. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Koreeda and O'Leary to connect any portions of the system – the user device, the agent device or the settlement device – together using a private line for data transmission, to allow for faster and more secure data transmission between system components.

Regarding Claim 6, further method claim would have been obvious from system claims rejected above, Claims 1 – 3, in combination, and is therefore rejected using the same art and rationale.

Regarding Claim 12, further device claim would have been obvious from system claims rejected above, Claims 1 - 3, in combination, and is therefore rejected using the same art and rationale.

Regarding Claim 13, further device claim would have been obvious from system claims rejected above, Claims 1 - 3, in combination, and is therefore rejected using the same art and rationale.

Regarding Claim 16, further method claim would have been obvious from system claims rejected above, Claims 1 - 3, in combination, and is therefore rejected using the same art and rationale.

Regarding Claim 20, further computer readable medium claim would have been obvious from system claims rejected above, Claims 1 - 3, and is therefore rejected using the same art and rationale.

Regarding Claim 23, further computer readable medium claim would have been obvious from system claims rejected above, Claims 1 - 3, and is therefore rejected using the same art and rationale.

Claims 7, 10 – 11, 18 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koreeda in view of Dogac (Dogac, Asuman, Ozsu, M. Tamer & Ulusoy, Ozgur. *Current Trends in Data Management Technology*. Idea Group Publishing. Hershey, PA. 1999. pp. 41 – 42) and Davis (Davis, Steven. *Pragmatics: A Reader*. Oxford University Press. New York, New York. 1991. pp. 217 – 219).

Regarding Claim 7, Koreeda discloses a user device (workstation) which is connected to Internet (computer network), browses a merchant site (shopping mall) on the Internet (computer network), and sends an instruction for purchasing a product on sale (product data) in the merchant site (shopping mall) said user device comprising:

- purchase-instruction inputting means (product selection unit) for inputting a purchase instruction of a product on sale (selecting product) in the browsed merchant site (shopping mall). (see col. 2, lines 44 – 56);

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- product-information downloading means for extracting (downloading) information regarding a product to be purchased (product data) from contents of the browsed merchant site (shopping mall). (see col. 6, lines 32 - 54); and
- purchase-instruction sending means (transmission unit) for sending, as a purchase instruction, the information regarding the product (product data) and being downloaded by said product-information downloading means (downloaded) and the information regarding the settlement means, together with ID information of a user (personal data), to an agent device (service center) which is prepared separately from the merchant site (shopping mall) and intermediates in a purchase process between the merchant site (shopping mall) and said user. (see col. 6, lines 32 – col. 7, line 2).

Koreeda does not teach a user device comprising:

- product-information extraction means for extracting information regarding a product to be purchased from contents of the browsed merchant site and information regarding specified settlement means; and
- purchase-instruction sending means for sending, as a purchase instruction, the information regarding the product and being extracted by said product-information extraction means and the information regarding the settlement means, together with ID information of a user, to an agent device which is prepared separately from the merchant site and

intermediates in a purchase process between the merchant site and said user.

Extraction of information from merchant sites is old and well known in the arts of information technology and e-commerce. As evidenced by Dogac which states "Shopbot is able to visit over a dozen of software vendors, extract information, and summarize results for the user." (see p. 41). It would have been obvious to one with ordinary skill in the art to have modified Koreeda to have incorporated the ability to extract information from merchant websites, as disclosed by Dogac, to allow for use of a third-party procurement and settlement system, as disclosed by Koreeda, with existing merchant sites on the world-wide web.

Specifying settlement means, such as acceptable credit cards, by a retailer or seller, either in an online environment or in a brick-and-mortar environment, is old and well known in the art of sales and retailing. As is evidenced by Davis which references a potential patron calling a restaurant to inquire about acceptable forms of payment for a planned future purchase. (see The Caller's Plan, p.218). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modified Koreeda and Dogac to allow for the extraction of information regarding settlement means to allow for individual sellers to specify settlement means and receive payment in said specified settlement means.

Davis does not teach that the gathering of "information regarding settlement means" is automatic. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have automated the method, since it has been

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held that broadly providing a mechanical or automatic means to replace manual activity that accomplishes the same result involves only routine skill in the art. *In re Venner*, 120 USPQ 192.

Regarding Claim 10, Koreeda discloses a user device (workstation) wherein said processor executes the program stored in said memory, thereby:

- accessing said merchant site (shopping mall) from said communications device (transmission unit), and controlling said communications device to receive contents of said merchant site. (see col. 5, line 33 – col. 6, line 2);
- displaying the contents of the merchant site which are received by said communications device on said display device (see figure 5);
- permitting the user to input an instruction for purchasing a product on sale in the contents of the merchant site which are displayed on said display device (see MARK button – figure 5);
- downloading information (downloading) regarding the product to be purchased (product data) from the contents of the merchant site (shopping mall) displayed on said display device. (see col. 6, lines 32 – 54); and
- controlling said communications device (transmission unit) to send, as a purchase instruction, downloaded (downloaded) information regarding the product (product data), together with ID information of the user (personal data) to an agent device (service center), which is prepared separately from the merchant site (shopping mall) and intermediates in a product

purchase process between said user device (work station) and said merchant site (shopping mall). (see col. 6, lines 32 – col. 7, line 2).

Koreeda does not teach a user device (workstation) wherein said processor executes the program stored in said memory, thereby:

- extracting information regarding the product to be purchased from the contents of the merchant site displayed on said display device and information regarding specified settlement means; and
- controlling said communications device to send, as a purchase instruction, extracted information regarding the product and the information regarding the settlement means, together with ID information of the user to an agent device, which is prepared separately from the merchant site and intermediates in a product purchase process between said user device and said merchant site.

Extraction of information from merchant sites is old and well known in the arts of information technology and e-commerce. As evidenced by Dogac which states "Shopbot is able to visit over a dozen of software vendors, extract information, and summarize results for the user." (see p. 41). It would have been obvious to one with ordinary skill in the art to have modified Koreeda to have incorporated the ability to extract information from merchant websites, as disclosed by Dogac, to allow for use of a third-party procurement and settlement system, as disclosed by Koreeda, with existing merchant sites on the world-wide web.

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Specifying settlement means, such as acceptable credit cards, by a retailer or seller, either in an online environment or in a brick-and-mortar environment, is old and well known in the art of sales and retailing. As is evidenced by Davis which references a potential patron calling a restaurant to inquire about acceptable forms of payment for a planned future purchase. (see The Caller's Plan, p.218). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modified Koreeda and Dogac to allow for the extraction of information regarding settlement means to allow for individual sellers to specify settlement means and receive payment in said specified settlement means.

Davis does not teach that the gathering of "information regarding settlement means" is automatic. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have automated the method, since it has been held that broadly providing a mechanical or automatic means to replace manual activity that accomplishes the same result involves only routine skill in the art. *In re Venner*, 120 USPQ 192.

Regarding Claim 11, further method claim would have been obvious from device claim rejected above, Claim 10, and is therefore rejected using the same art and rationale.

Regarding Claim 18, further computer readable medium claim would have been obvious from device claim rejected above, Claim 10, and is therefore rejected using the same art and rationale.

Regarding Claim 22, further program data signal claim would have been obvious from device claim rejected above, Claim 10, and is therefore rejected using the same art and rationale.

Claims 8 – 9 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koreeda, Dogac and Davis, as in Claims 7 and 19 above, in further view of Lomax (Lomax, Paul. *Learning VBScript*. O'Reilly & Associates, Inc. Sebastopol, California. 1997. pp. 457 – 459).

Regarding Claim 8, neither Koreeda, Dogac nor Davis teach a user device further comprising:

- merchant-site determination means for determining whether the merchant site is browsed; and
- instruction-input permission means for permitting, when said merchant-site determination means determines that the merchant site is browsed, an input of an instruction from said purchase-instruction inputting means.

User-tracking and session-tracking on merchant sites via cookies and objects are old and well-known in the art of computer programming and e-commerce system design. As evidenced by Lomax which states “For instance, some shopping cart software utilizes a cookie file on your hard drive to store order information as you browse the store. Then, when you reach the virtual check-out counter, the cookie file is read back into the final order page. Other shopping cart applications assign you a unique number as you enter the site.” (see pp. 457 – 458). It would have been obvious

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to one of ordinary skill in the art at the time the invention was made to have modified Koreeda, Dogac and Davis by incorporating a merchant-site determination means (cookie or object), as disclosed by Lomax, to allow for tracking of a user's browsing of a merchant site, and incorporating an instruction-input permission means (cookie detection) for permitting, when said determination means determines the merchant site is browsed (cookie), an input of an instruction from said purchase-instruction inputting means (submission of shopping cart), to allow for tracking of a user and linking that user's order with a particular merchant site.

Regarding Claim 9, Koreeda discloses a user device wherein:

- said purchase-instruction inputting means (product selection via download and transmission of selected product data to service center) is prepared separately from instruction means included in the contents of the browsed merchant site (product selection via website). (see col. 2, lines 44 – 56).

Regarding Claim 19, further computer readable medium claim would have been obvious from device claim rejected above, Claim 8, and is therefore rejected using the same art and rationale.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason M. Borlinghaus whose telephone number is (571) 272-6924. The examiner can normally be reached on 8:30am-5:00pm M-F.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung Sough can be reached on (571) 272-6799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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